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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,727	11/03/2003	Jonathan D. Root	1001.1426103	3544
28075	7590	09/20/2005	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			HO, UYEN T	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/699,727	<b>Applicant(s)</b> ROOT ET AL.	
	<b>Examiner</b> (Jackie) Tan-Uyen T. Ho	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 37-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/2&amp;2/26&amp;12/06/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement filed 2/2/04, 2/26/04 and 12/06/04 is acknowledged and considered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 37-39, 44-49, and 50-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Barbut et al. (5,997,557).

In regard to claims 37, 47-50, Barbut et al. disclose an apparatus and method for ablation of ectopic foci including the steps of: providing catheter comprising an ablation device at distal end and a filter (69) on a distal region of the catheter; inserting the catheter into a vessel; positioning the filter; positioning the ablation device adjacent the ectopic foci; expanding the filter; and ablating the ectopic foci, wherein the material released during ablation are captured by the filter (col. 20, line 20 to col. 22, line 62) and aspirating the excised plaque material. In figure 21, Barbut et al. disclose a step of "repositioning the ablation instrument while the expanded filter remains in position" by using the positioning fingers to bias the atherectomy assembly (80) including the ablation device toward or away from plaque or ectopic foci (fig. 21, col. 22, lines 42-46).

In regard to claims 44, 52, Barbut et al. disclose the filter (75, fig. 1) mounted on a sheath (51) having a lumen which carries the catheter (80) having the ablation device (fig. 1, 2).

In regard to claim 45, Barbut et al. disclose the catheter including a lumen communicating with an aspiration port at the distal end (82, fig. 1, 2).

In regard to claim 46, Barbut et al. disclose the filter surrounds the ablation device (figs. 1-22A).

In regard to claim 51, Barbut et al. disclose a step of aspirating material from the aspiration port (col. 22, line 52-53 & col. 12, line 25-35).

In regard to claim 53-55, Barbut et al. disclose the step of positioning the ablation instrument adjacent the ectopic foci follows the step of positioning the filter (col. 17, line 49 to col. 19, line 12, the filter is positioned first and the finger element bias the atherectomy assembly toward or away from the ectopic foci)

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barbut et al. (5,997,557) in view of Winston et al. (6,228,076). Barbut et al. disclose a method for ablation of abnormal tissue using an apparatus including an ablation device and a filter. In column 14, lines 52-67, Barbut et al. suggest cutting means 81 and

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suction means 82 may be replaced by any of a number of atherectomy working element. Although, the Barbut et al. ablation device is not a thermal, laser or microwave ablation device, attention is directed to the Winston et al. reference which disclose an abnormal tissue ablation apparatus including a thermal, laser or microwave ablation device (col. 4, lines 13-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a thermal, laser or microwave ablation device into the Barbut et al. apparatus wherein so doing would amount to mere substitution of one ablation device for another within the same art that would perform equally well in the Barbut et al. apparatus.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 37-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,235,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter.

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8. Claims 47-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,673,090. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain the same subject matter.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho  
Patent Examiner  
Art Unit 3731

September 15, 2005